

### **REMARKS**

This amendment is responsive to the Office Action dated December 5, 2001. Following the instant Amendment, Claims 1-20 are still pending in the present application. Applicant has specifically addressed each and every one of the Office Action's comments to the Claims in the amendments and remarks herein. Thus, Applicant respectfully submits that the remaining claims, as amended herewith, are allowable and an early notification of allowance is requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE.**" For the convenience of the Office, all of Applicant's claims 1-20 are re-written therein for reference and the amended claims are indicated as such.

This response is being filed within five (5) months from the mailing date of the Office Action and a Petition for an Extension of Time for a two-month extension is filed herewith along with the appropriate fee.

#### **I. Telephone Conference With Examiner**

Applicant notes with appreciation the courtesy and help extended by the Examiner during the telephone conferences with Applicant's representative. During the telephone conference, the Examiner kindly agreed that the claims, as amended in the proposed amendment and

incorporated herein, now provided a clearer explanation of the subject invention. Accordingly, the amendments are incorporated herein for purposes of clarification and not for limitation.

The Examiner stated that the instant amendments should overcome the rejections under the cited prior art references as a result of the clarification of the subject matter claimed. However, the Examiner reserved the right to conduct an additional prior art search.

## **II. Rejection of Claims Under 35 USC §103**

The Office Action rejected Claims 1-15 and 17-19 under 35 USC 103(a) as being unpatentable over US Pat. No. 5,905,736 to Ronen et al. ("Ronen") in view of US Pat. No. 6,141,653 to Conklin et al. ("Conklin"). Applicant respectfully traverses the rejection and the interpretation and combination of the references.

Regarding **Claim 1**, the Office Action claims that Ronen teaches a communications enhancement means for providing information regarding a related subject matter from an alternate source. Applicant respectfully traverses the rejection and the interpretation of Ronen and has herewith amended Claim 1 to more specifically define Applicant's invention. Applicant respectfully asserts that Ronen, at the very least, fails to provide a communication enhancement means that provides related information from a second source to a first source depending on the user's interaction with the first source, in an autonomous manner. Contrary to Applicant's invention as claimed, Ronen teaches a method for performing centralized billing transactions on

a billing platform that allows communication between an Internet access provider (IAP) and an Internet service provider (ISP).

“With reference back to FIG 2, after receiving the home-page on his or her screen, the user, at step 208, inputs the URL address of the desired Internet Service Provider with which he or she desires to conduct a transaction, and in response, receives a response from the ISP. At step 209, the user inputs a service request that will incur a transaction charge, such as requesting access to specific information, or requesting downloading of software. At step 210 the IAP routes the request to the ISP.”

(Column 7, lines 6-15) Accordingly, Ronen only provides a platform where billing information can be transmitted between an IAP that is being used by a user to contact an ISP from which a product is ordered. Therefore there is no second source, which may be another URL, that provides information regarding a related topic that is the subject of the user’s interaction with the first source as taught by Applicant.

In fact, Ronen teaches away from Applicant’s invention by requiring that, “If the user wants additional services, he or she returns to step 208 to input the URL of the desired ISP if a different ISP is desired, or to step 209 if further service from the same ISP is desired.” (Column 8, lines 4-7). Therefore, not only does Ronen fail to teach providing further information regarding a related topic from a second source, it even fails to teach providing further information from the same source and requires that the user reenter the URL of the same source to conduct another transaction thereon.

Besides failing to teach the limitations of Applicant's Claim 1 as illustrated above, the Office Action inappropriately attempts to combine Conklin with Ronen in an attempt to render Claim 1 obvious. The Office Action, on page 3, admits that "Ronen does not explicitly disclose[s] the related subject matter from the alternate source is determined from the interaction of the client with said first source and is autonomously provided thereto." However, the Office Action improperly claims that the abstract, col. 1, lines 41-47, and lines 30-64 of Conklin are "seen to read as a business transaction for providing customer additional sales services along with product sales." (Office Action, page 3)

First, it is well settled that the reference itself must suggest the modification or combination proposed in order for the modification or combination to be valid; "[the] invention cannot be found obvious unless there was some explicit teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). "The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound." *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added).

The abstract, Column 1, lines 41-47, and Column 7, lines 30-64, and in fact all of Conklin fails to teach the autonomous presentation of a related product from an alternate source as a result of the user's interaction with a first source. Accordingly, Conklin fails to suggest the modification thereto or the combination thereof with Ronen, which also fails to suggest the same. In fact, if Conklin did suggest such a combination, there would be no need to interpret the teaching thereof as done in the office action. Column 1, lines 41-47 discusses business

negotiations involving a number of variables and fails to teach the autonomous provision of a related additional product as a result of that negotiation. Column 7, lines 30-64 discusses payment methods for business transactions of the prior art and the “battle of the forms” involved therewith and also fails to teach the autonomous provision of a related product as a result of the payment method. In fact, Conklin teaches away from Applicant’s invention by stating that it provides an environment for negotiations between buyers and sellers and does not teach Applicant’s invention. (Column 13, line 65 to Column 14 line 26).

Second, it is apparent that the Office Action is misinterpreting the “(interaction with client)” limitation of Applicant’s invention. Applicant has amended “client” to “user” to clarify the limitation of Applicant’s invention. Accordingly, “interaction with user” limitation of applicant’s invention occurs before the additional product or service is offered and not, as asserted in the Office Action, as an approval for the acceptance of the additional product or service offered. Even if providing of warranty or insurance is known, as claimed by the Office Action, there is no indication as to where that information is being provided from. Such products are always provided by the same source from which the original purchase is made.

In addition, the Office Action takes Official Notice that transferring of information to a user from an autonomous source is old and well known. Even if the modification is legally justified, the modification would still fail to teach the limitations of Applicant’s invention or render the same obvious. The information provided from the autonomous source is as a result of the client’s interaction with a first website, a limitation which is neither contemplated nor taught by Ronen or Conklin, or a combination thereof.

Third, Applicants respectfully submit that the Office Action is improperly using “hindsight” and the teachings of Applicants’ own claimed invention in order to combine references to render Applicant’s claims obvious. The Office Action admits that Ronen and Conklin fail to teach all of the limitations of Applicant’s claimed invention. However, the Office Action improperly attempts to modify and combine Conklin, which also fails to teach all of the limitations of Applicant’s claimed invention, with Ronen in an attempt to achieve Applicant’s claimed invention.

As a result, Applicant respectfully asserts that Ronen and Conklin fail to teach, either alone or in combination, the provision of information from a second source that is related to the interaction of the user on a first source as claimed by Applicant, and therefore fails to teach all of the limitations of Applicant’s claim. Accordingly, Applicant respectfully requests the withdrawal of the rejection of Claim 1.

Regarding **Claim 2**, the Office Action contends that Ronen discloses all of the limitations of Claim 1 and further contends that item 204 of figure 2 of Ronen teaches the display component of Applicant as set forth in Claim 2. Applicant respectfully traverses the rejection and the interpretation of Ronen and, because Claim 2 depends from Claim 1 and includes the novel limitations thereof, Applicant incorporates herein the remarks set forth above as to the novelty and unobviousness of Claim 1 and, as a result of the dependency thereof, respectfully asserts that Claim 2 is also novel and unobvious.

Furthermore, Applicant respectfully asserts that the display component of Ronen is not provided to present information from a second source in response to the user's interaction with the first source as taught by Applicant. Conversely, Ronen's display component is in fact the first source,

At step 202 the IAP accepts the call and, at step 203, engages in a user-IAP handshake protocol in which the user's identity is provided and authenticated by the IAP as a valid subscriber to that IAP's access service. The IAP then assigns an IP address to the session for use by the user's terminal. At step 204, in response to a successful handshake, a home-page appears on the user's screen.

(Column 6, lines 56-62). Applicant respectfully asserts that Ronen fails to teach the display component as claimed by Applicant and therefore cannot anticipate or render Claim 2 obvious, in addition any modification thereof is clearly not supported by the reference. As a result, Applicant respectfully requests the withdrawal of the rejection of Claim 2 because it is neither obvious nor anticipated.

Regarding **Claim 3**, the Office Action sets forth the exact same rejection as in the previous Office Action and fails to address Applicant's arguments filed in response thereto even though the same exact reference is used. Accordingly, because the Office Action fails to comply with MPEP §707.07, as set forth in detail above, Applicant asserts the following arguments and requests that the Office provide an itemized response to Applicant's arguments.

Regarding Claim 3, the maintenance of the rejection thereof under Ronen is clearly contradictory to the Office Action's admittance in regard to Claim 1 that "Ronen does not explicitly disclose the related subject matter from the alternate source is determined from the

interaction of the client with said first source and is autonomously provided thereto.” The Office Action clearly admits that Ronen fails to teach the user of a first source receives information from a second source and cannot maintain the instant rejection. Nevertheless, Applicant responds as follows:

The Office Action contends that Ronen discloses all of the limitations of Claim 1 and further contends that item 105 of figure 1 and items 209, 210, and 216 of figure 2 of Ronen teaches the request from the first source to the second source for related information as claimed by Applicant. Applicant respectfully traverses the rejection and the interpretation of Ronen and, because Claim 3 depends from Claim 1 and includes the novel limitations thereof, Applicant incorporates herein the remarks set forth above as to the novelty of Claim 1 and, as a result of the dependency thereof, respectfully asserts that Claim 3 is also unobvious and novel.

Applicant respectfully asserts that, as more fully set forth above, item 209 is the input of a service request by the user and does not involve a request being sent from a first source to a second source as claimed. In addition, item 210 teaches the connection of the IAP to the ISP and does not provide for a request from a first source or a supply of information from a second source as claimed. (Please see Column 7, lines 7-15). In addition, item 216 of Ronen is the denial of a transaction if the user has failed to provide sufficient information to confirm the same. (Please see Column 7, lines 26-30). Accordingly, because Ronen fails to teach all of the limitations of Claim 3 or render the same obvious, Applicant respectfully requests the withdrawal of the rejection thereof.



Regarding **Claim 4**, the Office Action sets forth the exact same rejection as in the previous Office Action and fails to address Applicant's arguments filed in response thereto even though the same exact reference is used. Accordingly, because the Office Action fails to comply with MPEP §707.07, as set forth in detail above, Applicant asserts the following arguments and requests that the Office provide an itemized response to Applicant's arguments.

The maintenance of the rejection of Claim 4 under Ronen is clearly contradictory to the Office Action's admittance in regard to Claim 1 that "Ronen does not explicitly disclose the related subject matter from the alternate source is determined from the interaction of the client with said first source and is autonomously provided thereto." The Office Action clearly admits that Ronen fails to teach the user of a first source receives information from a second source and cannot maintain the instant rejection. In addition, the Applicant asserts as follows:

The Office Action contends that Ronen discloses all of the limitations of Claims 1 and 3 and further contends that items 209, 210, 216 and 217 of figure 2 of Ronen teaches the request of related information from the first source and the provision thereof from the second source as claimed by Applicant. Applicant respectfully traverses the rejection and the interpretation of Ronen and, because Claim 4 depends from Claims 1 and 3 and includes the novel and unobvious limitations thereof, Applicant incorporates herein the remarks set forth above as to the novelty and unobviousness thereof and, as a result of the dependency thereof, respectfully asserts that Claim 4 is also novel and unobvious.

Applicant respectfully asserts that steps 216 and 217 Ronen teaches the delivery of a

requested item to a user, such as downloading of software, if a billing mechanism for the user is provided. (Please see Column 7, lines 52-60) Ronen does not teach sending a request from the first source to the second source for information that is related to the interest of the user on the first source and the provision thereof. Accordingly, Applicant respectfully requests the withdrawal of the rejection of Claim 4 for at least the foregoing reasons.

Regarding **Claim 10**, the Office Action asserts that Ronen teaches most of the limitations thereof in items 209, 210, 217, and 227 of figure 2 except that "Ronen does not explicitly disclose whereby the interaction of said client with said first source determine the information furnished by said second source without requiring a specific client request." However, the Office Action improperly attempts to combine Conklin to unsuccessfully teach the limitations of Applicant's Claim 10. Applicant respectfully traverses the rejection and the interpretation and combination of the references and asserts that Claim 10 is novel and unobvious. Applicant respectfully asserts that Ronen, at the very least, fails to provide an Internet system for generating an additional order that provides related information from a second source to a first source depending on the user's interaction with the first source without requiring the user to specifically request the same.

The IAP and ISP of Ronen are not the equivalent of the first source and second source as claimed by Applicant. Ronen's IAP allows a user to connect to an ISP by requiring that the user input "the URL address of the Internet Service Provider with which the user desires to interact." (Column 3, lines 26-28) Therefore, Ronen does not teach Applicant's invention as claimed wherein as a result of the users interaction with a first web page, a second web page provides

related information to the interest of the user without requiring the user enter a specific URL address for the second web page. In addition, the IAP of Ronen serves to store personal billing information regarding a client and allows an execution of a transaction by billing the client for a transaction consummated on a specific web page. (Please see Column 7, lines 51-67).

Besides failing to teach all of the limitations of Applicant's Claim 10 as illustrated above, the combination of Conklin and the Official notice taken in the Office Action is clearly inappropriate. Nevertheless, the Office Action improperly claims that the abstract, col. 1, lines 41-47, and lines 30-64 of Conklin are "seen to read as a business transaction for providing customer additional sales services along with product sales." (Office Action, page 3) The Office Action, on pages 4-5, attempts to take modify Conklin through Official Notice of teaching Applicant's limitations which are clearly absent from Conklin. Just because customers are provided with additional sales services along with product sales (i.e. warranty or insurance) in the non-Internet world, it is not obvious to one of ordinary skill in the art to implement Applicant's limitations into a reference that neither contemplates or needs such a system.

First, it is well settled that the reference itself must suggest the modification or combination proposed in order for the modification or combination to be valid; "[the] invention cannot be found obvious unless there was some explicit teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). "The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound." *In re*

*Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added).

The abstract, Column 1, lines 41-47, and Column 7, lines 30-64, and in fact all of Conklin fails to teach the autonomous presentation of a related product from an alternate source as a result of the user's interaction with a first source. Accordingly, Conklin fails to suggest the modification thereto or the combination thereof with Ronen, which also fails to suggest the same. In fact, if Conklin did suggest such a combination, there would be no need to interpret the teaching thereof as done in the office action. Column 1, lines 41-47 discusses business negotiations involving a number of variables and fails to teach the autonomous provision of a related additional product as a result of that negotiation. Column 7, lines 30-64 discusses payment methods for business transactions of the prior art and the "battle of the forms" involved therewith and also fails to teach the autonomous provision of a related product as a result of the payment method. In fact, Conklin teaches away from Applicant's invention by stating that it provides an environment for negotiations between buyers and sellers and does not teach Applicant's invention. (Column 13, line 65 to Column 14 line 26).

Second, it is apparent that the Office Action is misinterpreting the "(interaction with client)" limitation of Applicant's invention. Applicant has amended "client" to "user" to clarify the limitation of Applicant's invention. Accordingly, "interaction with user" limitation of applicant's invention occurs before the additional product or service is offered and not, as asserted in the Office Action, as an approval for the acceptance of the additional product or service offered. Even if providing of warranty or insurance is known, as claimed by the Office Action, there is no indication as to where that information is being provided from. Such products are always provided by the same source from which the original purchase is made.

In addition, the Office Action takes Official Notice that transferring of information to a user from an autonomous source is old and well known. Even if the modification is legally justified, the modification would still fail to teach the limitations of Applicant's invention or render the same obvious. The information provided from the autonomous source is as a result of the client's interaction with a first website, a limitation which is neither contemplated nor taught by Ronen or Conklin, or a combination thereof.

Third, Applicants respectfully submit that the Office Action is improperly using "hindsight" and the teachings of Applicants' own claimed invention in order to combine references to render Applicant's claims obvious. The Office Action admits that Ronen and Conklin fail to teach all of the limitations of Applicant's claimed invention. However, the Office Action improperly attempts to modify and combine Conklin, which also fails to teach all of the limitations of Applicant's claimed invention, with Ronen in an attempt to achieve Applicant's claimed invention.

Fourth, the Office Action recognizes the advantages of the presently claimed invention by trying to make modifications in Ronen and Conklin to provide an autonomous upsale presentation. Applicant respectfully submits that the fact that the modification produces advantages in allowing the introduction of products to a user as a result of the user's interaction with a first website militates in favor of the patentability of Applicant's claimed invention because it proves that the combination produces new and unexpected results and hence is unobvious.

Finally, if Applicant's claimed invention were in fact obvious, those skilled in the art

would have modified the teachings of Ronen to incorporate the teachings of Conklin and the Official Notice. The fact that neither Ronen nor Conklin has been modified, since their teachings have been known for several years, to implement Applicant's claimed invention, despite its great advantages, indicates that Applicant's claimed invention is neither obvious nor taught by the prior art.

As a result, Applicant respectfully asserts that Ronen and Conklin fail to teach, either alone or in combination, the provision of information from a second source that is related to the interaction of the user on a first source as claimed by Applicant, and therefore fails to teach all of the limitations of Applicant's claim. Accordingly, Applicant respectfully requests the withdrawal of the rejection of Claim 10.

Regarding **Claim 11**, the Office Action sets forth the exact same rejection as in the previous Office Action and fails to address Applicant's arguments filed in response thereto even though the same exact reference is used. Accordingly, because the Office Action fails to comply with MPEP §707.07, as set forth in detail above, Applicant reasserts its previously filed arguments and requests that the Office provide an itemized response to Applicant's arguments. The Office Action rejected the same and applied the same reasoning as applied in Claim 2. Applicant respectfully incorporates the remarks above set forth as to the novelty and unobviousness of Claim 2 and further incorporates the remarks above as to the novelty of Claim 10. Accordingly, Applicant respectfully asserts that Ronen fails to teach all of the limitations of Claim 11 and respectfully requests the withdrawal of the rejection thereof.

Regarding **Claim 17**, the Office Action asserts that Ronen discloses the Internet system of claim 10, wherein said first source is a first web page at a first IP address and said second source has a second IP address (Fig. 1, items 104 and 107). Applicant's first web page requests information from a second location having a differing IP address, a limitation which is not taught by Ronen. Ronen's item 104 is the Internet Access Provider which allows connection to item 107 which is the Internet Service Provider. Accordingly, there is no provision of information between the ISP and IAP of Ronen that would either anticipate or render obvious the limitations of Applicant's invention as claimed. In addition, because Claim 17 depends from Claim 10, it incorporates the novel limitations thereof that further define the same over the teachings of Ronen. Accordingly, Applicant respectfully requests the withdrawal of the rejection of Claim 17 for at least the above set forth reasons.

Regarding **Claim 5**, the Office Action claims that the limitations of Claim 4 are taught by Ronen; however, the Office Action admits that Ronen fails to teach a purchase transaction with the first source. The Office Action further takes Official Notice that IAPs provide products and services from their web sites. Applicant respectfully traverses the rejection of Claim 5 and the interpretation and modification of Ronen.

Applicant hereby incorporates the remarks above set forth as to the novelty and unobviousness of Claims 1, 3, and 4, from which Claim 5 depends, and respectfully asserts that Ronen fails to teach all of the limitations thereof.

First, it is well settled that in order for a modification or combination of the prior art to be

valid, the prior art itself must suggest the modification or combination. Ronen fails to suggest a logical reason to modify the reference as proposed. Ronen is individually complete and functional independently for its limited specific purposes and therefore there would be no reason to make the modification proposed by the Office Action. Ronen's IAP only allows users to access ISPs to conduct transactions and the IAP is only used to store and transmit user information to a billing platform. Accordingly, the IAP does not allow transactions to be conducted thereon.

Second, even if the modification was legally justified, it still would not render Applicant's invention obvious. Applicant's invention allows the autonomous transmission from a second source information that is related to the interest of the user on a first source. Conversely, Ronen fails to teach a first source and second source that are able to interact without requiring express input from the user as taught by Applicant. "By inputting the URL address of the Internet Service Provider with which the user desires to interact, the user may be connected to various ISPs, such as 106 and 107." (Column 3, lines 26-28).

Third, even if the modification was legally justified, the references would not meet all of the limitations disclosed in Applicant's claims. For purposes of illustration but not limitation, Ronen fails to teach the interaction between the first source and the second source to autonomously provide additional information that is of interest to the user.

Finally, if Applicant's invention were in fact obvious, those skilled in the art would have modified the Ronen's invention by now to cover the advantages of Applicant's invention. The



fact that Hellermann has not been modified since its teachings were known since at least 1996 to implement Applicant's invention, despite its great advantages, indicates that Applicant's invention is not obvious. Accordingly, Applicant respectfully requests the withdrawal of the rejection of Claim 5 for at least the aforementioned reasons.

Regarding **Claim 6**, the Office Action asserts that Ronen in view of the Examiner's Official Notice discloses the invention of Claim 5, and further asserts that Ronen teaches an actuation means being included with the transferred information. Applicant respectfully traverses the rejection and the modification and interpretation of Ronen. Applicant incorporates herein the arguments set forth above as to the novelty of Claims 1, 3, 4, and 5.

The Office Action cites Column 8, lines 1-7 in support of its contention that Ronen teaches an actuation means as claimed by Applicant. However, Ronen fails to teach an actuation means and expressly requires that the user input the URL of the desired site in order to visit the site to make an additional transaction, "If the user wants additional services, he or she returns to step 208 to input the URL of the desired ISP if a different ISP is desired, or to step 209 if further service from the same ISP is desired." (Column 8, lines 4-7) Accordingly, the input of a desired URL is not similar to Applicant's claimed invention of providing information regarding a particular good and/or service and allowing the user to purchase the same by using an actuation means. Therefore, even if the modification of Ronen were legally justified, it would fail to render Applicant's invention obvious. As a result, Applicant respectfully requests the withdrawal of the rejection of Claim 6.

Regarding **Claim 7**, the Office Action asserts that Ronen in view of the Examiner's Official Notice discloses the invention of Claim 6, and further asserts that Ronen teaches that upon activation of the actuation means by the user, a set of data is transferred between the web pages. Applicant respectfully traverses the rejection and the modification and interpretation of Ronen. Applicant incorporates herein the arguments set forth above as to the novelty of Claims 1, 3, 4, 5, and 6.

The Office Action cites Figure 2 and items 209, 210, 216, 217, and 227 of Ronen in support of its rejection of Claim 7. Applicant respectfully asserts that even if the modification of Ronen were legally justified, it still would fail to teach all of the limitations of Applicant's invention. Besides failing to teach Applicant's first source and second source as claimed, Ronen's items 209, 210, 216, 217, and 227 are directed to a billing platform wherein the user must input the information before proceeding. Conversely, Applicant's Claim 7 teaches the transfer of information, which may be billing information, from a first source to a second source upon actuation of an actuation means which Ronen fails to teach. Accordingly, Applicant respectfully asserts that Ronen does not render Claim 7 obvious and respectfully requests the withdrawal of the rejection.

Regarding **Claim 8**, the Office Action asserts that Ronen in view of the Examiner's Official Notice discloses the invention of Claim 7. The Office Action admits that Ronen fails to teach Applicant's payment means, delivery means, and client identifying means being at least included in said data. However, the Office Action attempts to improperly modify Ronen to incorporate Applicant's teaching of the transfer of the payment means, delivery means, and

identifying means. Applicant respectfully traverses the rejection and the modification and interpretation of Ronen. Applicant incorporates herein the arguments set forth above as to the novelty of Claims 1, 3, 4, 5, 6, and 7.

It is well settled that in order for a modification to be proper, the prior art reference must suggest the modification. Ronen fails to provide any justification for the modification. Ronen, as admitted on page 6 of the Office Action, only teaches the transfer of information from the IAP to the ISP, which are not the first and second source as claimed by Applicant. Accordingly, because Ronen teaches a centralized billing system for transactions conducted on the Internet, there would be no need to provide billing information to a second source as claimed by Applicant. Accordingly, Ronen does not even contemplate the exchange of information between two different sources. Therefore, Applicant respectfully requests the withdrawal of the rejection of Claim 8 because Ronen fails to render the same obvious.

Regarding **Claim 9**, the Office Action asserts that Ronen in view of the Examiner's Official Notice discloses the invention of Claim 8. The Office Action admits that Ronen fails to teach Applicant's second display component that requests entry of the payment means, delivery means, and the client identifying means. However, the Office Action attempts to improperly modify Ronen to incorporate Applicant's limitations. Applicant respectfully traverses the rejection and the modification and interpretation of Ronen. Applicant incorporates herein the arguments set forth above as to the novelty of Claims 1, 3, 4, 5, 6, 7, and 8.

It is well settled that in order for a modification to be proper, the prior art reference must

suggest the modification. Ronen fails to provide any justification for the modification. Ronen teaches a centralized billing system for transactions conducted on the Internet wherein the IAP must have the client's information before the IAP will allow the client to engage in a transaction. Accordingly, because Ronen requires that all of the user's information be previously on record, there would be no need to have a second display component from a second source requesting the information. Accordingly, Ronen does not even contemplate Applicant's second component as supplied by the second source to gather information regarding the user. Therefore, Applicant respectfully asserts that the modification of Ronen is improper and fails to teach Applicant's invention. As a result, Applicant respectfully requests the withdrawal of the rejection of Claim 9.

Regarding **Claim 12**, the Office Action asserts the same rejection as applied to Claim 5 and asserts that it is inherent that the client provide a plurality of personal information to seller in order to complete an online sales transaction. Applicant respectfully traverses the rejection and the modification and interpretation of Ronen. Applicant incorporates herein the remarks above set forth as to the novelty and unobviousness of Claim 5 and the claims from which it depends. In addition, Applicant incorporates herein the remarks above set forth as to the novelty and unobviousness of Claim 10 from which Claim 12 depends.

It is well settled that in order for a modification of the prior art to be valid, the prior art itself must suggest the modification. Ronen, as previously admitted in the Office Action, fails to allow a transaction to be completed on the first source because Ronen's first source, the IAP, is used only to store information thereon. Accordingly, Ronen fails to provide a justification or

reason for the modification as proposed. Therefore, Applicant respectfully requests withdrawal of the rejection of Claim 12.

Regarding **Claim 13**, the Office Action asserts that Ronen in view of the Examiner's Official Notice discloses the invention of Claim 12 and further asserts that items 209, 210, and 216 of Ronen teach Applicant's limitation of requesting information from a second source by a first source. Applicant respectfully traverses the rejection and the modification and interpretation of Ronen. Applicant incorporates herein the arguments set forth above as to the novelty and unobviousness of Claims 5, 10, and 12.

Applicant respectfully asserts that even if the modification was legally justified, Ronen would fail to teach Applicant's invention as claimed. Ronen, as admitted on page 6 of the Office Action, only teaches the transfer of information from the IAP to the ISP, which consists of billing information only. Accordingly, Ronen does not teach or even contemplate or even require that a first source request related information of interest to a user from a second source. Accordingly, Ronen does not even contemplate the exchange of information between two different sources as claimed. Therefore, Applicant respectfully requests the withdrawal of the rejection of Claim 13 because Ronen fails to render the same obvious.

Regarding **Claim 14**, the Office Action asserts that Ronen in view of the Examiner's Official Notice discloses the invention of Claim 13 and further asserts that Ronen teaches Applicant's limitation of a second display means having a plurality of actuation means thereon.

Applicant respectfully traverses the rejection and the modification and interpretation of Ronen. Applicant incorporates herein the arguments set forth above as to the novelty and unobviousness of Claims 5, 10, 12, and 13.

Applicant respectfully asserts that Ronen fails to provide any justification for the modification and that even if the modification was legally justified, Ronen would fail to teach Applicant's invention as claimed. The Office Action admits on page 6 thereof that Ronen fails to teach a second display means, nevertheless, the Office Action attempts to improperly incorporate a second display means into Ronen even though a justification therefor is not provided. Ronen, as admitted on page 6 of the Office Action, only teaches a central billing system where the IAP has the user's information and bills the user for the transactions directly. Accordingly, Ronen does not teach or even contemplate or even require that a first source request related information of interest to a user from a second source and a second display component provide the same. In addition, as clearly set forth in Column 8, lines 1-12, Ronen requires that the user enter the URL of an alternate source if it desires to visit the second source and no second display means are provided therefor or even contemplated. Therefore, Applicant respectfully requests the withdrawal of the rejection of Claim 14 because Ronen fails to render the same obvious or provide any justification for the modification.

Regarding **Claim 15**, the Office Action asserts that Ronen in view of the Examiner's Official Notice discloses the invention of Claim 14 and further admits that Ronen fails to teach the transfer of information to a second source upon actuation of a second actuation means. Applicant respectfully traverses the rejection and the modification and interpretation of Ronen.

Applicant incorporates herein the arguments set forth above as to the novelty and unobviousness of Claims 5, 10, 12, 13, and 14.

Applicant respectfully asserts that Ronen fails to provide any justification for the modification and that even if the modification was legally justified, Ronen would fail to teach Applicant's invention as claimed. The Office Action admits on page 6 thereof that Ronen fails to teach a second display means and the transfer of information from a first source to a second source upon actuation of an actuation means. Nevertheless, the Office Action attempts to improperly incorporate a second display means into Ronen and an actuation means for the transfer of information even though a justification therefor is not provided. Ronen, as admitted in the Office Action, only teaches a central billing system which bills the client directly and does not need to transfer the information to a second source. Accordingly, Ronen does not teach or even contemplate or even require that a second source request personal information of a user from a first source or provide a second display component and an actuation means thereon for the request. Therefore, Applicant respectfully requests the withdrawal of the rejection of Claim 15 because Ronen fails to render the same obvious or provide any justification for the modification thereof.

Regarding **Claim 18**, the Office Action claims that Ronen and several modifications thereof will render Applicant's Claim 18 obvious. Applicant respectfully traverses the rejection and the interpretation and modification of the reference.

It is well settled that in order for a modification or combination of the prior art to be

valid, the prior art itself must suggest the modification or combination. As previously admitted in the Office Action, Ronen has a central billing system wherein the IAP bills the client for all transactions of the client during an on-line session. In addition, the Office Action admits that Ronen does not explicitly disclose a purchase transaction on the first site. Therefore, Ronen would not contemplate or require the personal information for a purchase transaction on the IAP site. Thus the reference itself fails to suggest a logical reason to modify the reference as proposed. Ronen is complete and functional independently for its limited specific purpose and there would be no reason to make the modification proposed by the Office Action.

Secondly, even if the modification was legally justified, the references would not meet all of the limitations disclosed in Applicant's claims. Applicant's invention as claimed allows a request to be sent to a second source for an item that is related to the subject matter of the transaction on the first source. As admitted in the Office Action, Ronen fails to teach Applicant's invention as claimed. However, the Office Action attempts to incorporate Amazon.com's related product suggestion in an attempt to teach Applicant's invention. Applicant respectfully traverses the modification and combination and asserts that even if the modification was made, Amazon.com's system only presents additional books from the same source and does not request additional products and/or services from additional sources.

Thirdly, even if the modification was legally justified, it still would not render Applicant's invention obvious. For purposes of illustration but not limitation, Applicant's invention provides an assenting actuation means to purchase the additional item from the second source. Conversely, as disclosed in Column 8 of Ronen, if an additional transaction is desired by



the user, the user must enter the URL of the alternate source and enter into another transaction. This is one of the disadvantages in the prior art that Applicant's invention overcomes by providing an assenting actuation means to the original source for the convenience of the user.

Fourthly, the Office Action admits that Ronen fails to disclose the transferring of personal information from the first source to the second source upon the user's assent to the transaction. As discussed in further detail above, Ronen only provides for a central billing service whereby the IAP stores the user's information and bills the user directly for transactions conducted on the Internet. Accordingly, there would be no reason to modify Ronen as proposed to allow the transfer of personal information because that is the function of the IAP itself and it must have the information prior to the user's transaction.

Finally, it appears that the Office Action is improperly using hind-sight and the teachings of Applicant's invention in order to modify Ronen to render obvious Applicant's Claim 18. For almost every limitation, the Office Action improperly attempts to modify Ronen to teach the limitations of Applicant's invention. Applicant respectfully asserts that the necessity of so many modifications mitigates in favor of Applicant and suggests that Applicant's invention is in fact not obvious.

Accordingly, Applicant respectfully requests the withdrawal of the rejection of Claim 18 for at least the aforementioned reasons.

Regarding Claim 19, the Office Action asserts that Ronen in view of the Official Notice

discloses method of Claim 18, and that item 210, 216, and 217 of Ronen teach Applicant's display provided by the second source containing the information thereon. Applicant respectfully traverses the rejection and the interpretation and modification of Ronen, and herein incorporates the remarks set forth above as to the novelty and unobviousness of Claims.

Applicant respectfully asserts that Ronen fails to provide any justification for the modification as proposed and that even if the modification was legally justified, Ronen would fail to teach Applicant's invention as claimed. The Office Action admits on page 6 that Ronen fails to teach a display means, nevertheless, the Office Action attempts to improperly incorporate a display means into Ronen even though a justification therefor is not provided. In addition, as clearly set forth in Column 8, lines 1-12, Ronen requires that the user enter the URL of an alternate source if it desires to visit the second source and no display means is provided therefor or even contemplated. Therefore, Applicant respectfully requests the withdrawal of the rejection of Claim 19 because Ronen fails to render the same obvious or provide any justification for the modification.

**B. Rejection of Claims 16 and 20 under §103(a)**

The Office Action rejected **Claim 16 and 20** under §103(a) as being unpatentable over Ronen in view of Official Notice as applied to Claims 12 and 18 above, and further in view of U.S. Pat. No. 4,992,940 to Dworkin ("Dworkin"). Applicant respectfully traverses the rejection and the interpretation and combination of the references.

Applicant respectfully asserts that the rejection of the claims based on the same reasoning

without addressing Applicant's previously filed remarks and arguments is improper. Section 707.07(f) of the MPEP provides as follows, "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." In addition, in the "Response to Arguments" section of the Office Action, it is claimed that the arguments are moot in view of the new ground(s) of rejection. Section 707.07 et. seq. of the Manual of Patent Examining Procedure clearly indicates that such a general refusal of Applicant's arguments is clearly inappropriate, "The examiner must, however, address any arguments presented by the Applicants which are still relevant to any references being applied." (emphasis added) The Ronen and Dworkin references are clearly reapplied verbatim by the Office in the rejection of the same claims, and therefore, the Applicant's arguments must be addressed. Accordingly, because the Office Action is incomplete and fails to comply with 37 CFR 1.104(b), Applicant respectfully requests the withdrawal of the finality of the Office Action, and requests that Applicant's arguments be specifically addressed such that Applicant may form a lucid response thereto. For the convenience of the Office, Applicant's previous response to the rejections is reprinted hereinbelow.

Regarding **Claim 16**, the Office Action asserts that Ronen discloses the system of Claim 12 and admits that Ronen fails to teach a database with previously stored information from a second source that provides a related item to the client on the first source and can consummate the transaction with the transfer of personal information. In addition, the Office Action asserts that Dworkin discloses a database with previously stored information from said second source communicates with said first source to provide a related item to said client on said first source and can be combined with Ronen to teach Applicant's invention. Applicant respectfully

traverses the rejection and combination of the references and incorporates herein the remarks above set forth in relation to the novelty and unobviousness of Claims 10 and 12.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. None of the references suggest a logical reason to modify the reference as proposed. Ronen and Dworkin are individually complete and functional independently for their limited specific purposes and therefore there would be no reason to make the modification proposed by the Office Action. Ronen teaches a central billing system and Dworkin basically provides a search engine for finding a desired product as specified by a user. Accordingly, there would be no reason to modify or combine the references as proposed.

Secondly, even if the modification was legally justified, it still would not render Applicant's invention obvious. Applicant's invention allows the automated request for a related product from a second source as a result of the user's passive interaction with the first source. Conversely, Dworkin generally teaches a search engine for locating a product that is actively searched for by a user, "In practicing the invention, the user must first tell the system the general type of product or service desired. This step can be done by selecting an appropriate item from a menu. In response to the user's choice, the system displays a template which gives various technical criteria for the product or service. By filling in one or more spaces on this template, the user can tell the system the criteria to be deemed minimum requirements." (Column 2, lines 6-13).

Thirdly, even if the modification was legally justified, the references would not meet all of the limitations disclosed in Applicant's claims. For purposes of illustration but not limitation, Dworkin fails to teach the provision of the related information from the database without requiring an express request from the user therefor. "The system enables the user to 'shop' for products meeting the user's own minimum requirements, and having the best price, without the need to consult individual catalogs or visit stores." (Column 3, lines 51-54).

Finally, if Applicant's invention were in fact obvious, those skilled in the art would have combined the Ronen's invention with that of Dworkin's by now to cover the advantages of Applicant's invention. The fact that Dworkin has not been modified since its teachings were known since at least 1989 with the teachings of Ronen whose teachings were known since at least 1996 to implement Applicant's invention, despite its great advantages, indicates that Applicant's invention is not obvious.

Accordingly, Applicant respectfully requests the withdrawal of the rejection of Claim 16 under Ronen in view of Dworkin for at least the aforementioned reasons.

Regarding **Claim 20**, the Office Action asserts that Ronen teaches the method of Claim 18 and admits that Ronen fails to teach the database communicating with the first source and presenting a display with information regarding an item to a user on the first source. However, the Office Action improperly attempts to combine Dworkin to teach the same. Applicant respectfully traverses the rejection and the combination and modification of the references. In addition, Applicant herein incorporates the remarks above set forth as to the novelty and

unobviousness of Claim 18.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination. None of the references suggest a logical reason to modify the reference as proposed. Ronen and Dworkin are individually complete and functional independently for their limited specific purposes and therefore there would be no reason to make the modification proposed by the Office Action. Ronen teaches a central billing system and Dworkin basically provides a search engine for finding a desired product as specified by a user. Accordingly, there would be no reason to modify or combine the references as proposed.

Secondly, even if the modification was legally justified, it still would not render Applicant's invention obvious. Applicant's invention allows the automated request for a related product from a second source as a result of the user's passive interaction with the first source. Conversely, Dworkin basically provides a search engine for locating a product that is actively searched for by a user, "In practicing the invention, the user must first tell the system the general type of product or service desired. This step can be done by selecting an appropriate item from a menu. In response to the user's choice, the system displays a template which gives various technical criteria for the product or service. By filling in one or more spaces on this template, the user can tell the system the criteria to be deemed minimum requirements." (Column 2, lines 6-13).

Thirdly, even if the modification was legally justified, the references would not meet all

of the limitations disclosed in Applicant's claims. For purposes of illustration but not limitation, Dworkin fails to teach the provision of the related information from the database without requiring an express request from the user therefor. "The system enables the user to 'shop' for products meeting the user's own minimum requirements, and having the best price, without the need to consult individual catalogs or visit stores." (Column 3, lines 51-54).

Finally, if Applicant's invention were in fact obvious, those skilled in the art would have combined the Ronen's invention with that of Dworkin's by now to cover the advantages of Applicant's invention. The fact that Dworkin has not been modified since its teachings were known since at least 1989 with the teachings of Ronen whose teachings were known since at least 1996 to implement Applicant's invention, despite its great advantages, indicates that Applicant's invention is not obvious.

Accordingly, Applicant respectfully requests the withdrawal of the rejection of Claim 20 by Ronen in view of Dworkin for at least the aforementioned reasons.

Applicant has reviewed the prior art made of record and not relied upon and respectfully asserts that none of the references either anticipates or renders obvious Applicant's invention.

### **III. Response to Arguments**

In the "Response to Arguments" section of the Office Action, it is claimed that the arguments are moot in view of the new ground(s) of rejection. Section 707.07 et. seq. of the

Manual of Patent Examining Procedure clearly indicates that such a general refusal of Applicant's arguments is clearly inappropriate, "The examiner must, however, address any arguments presented by the Applicants which are still relevant to any references being applied." (emphasis added) Except for Claims 1 and 18, the exact same rejections are clearly reapplied by the Office without addressing the Applicant's arguments which clearly overcome the rejections. Accordingly, respectfully pleads and requests that Applicant's arguments be specifically addressed such that Applicant may form a lucid response thereto.

### CONCLUSION

It is respectfully submitted that the case is now in condition for allowance, and an early notification of the same is requested. If it is believed that a telephone interview will help further the prosecution of this case, Applicant respectfully requestS that the undersigned attorney be contacted at the listed telephone number.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

1. (Twice Amended) A communications enhancement means for providing information regarding a related subject matter from an alternate source, comprising:

a [client] user accessing at least a first source [communicating with] located on at least a server that is located on a computer network;

5       at least [a first source and] a second source located on said server that is also located on the computer network;

a communication means relaying information between said first source and said second source; and

a display component allowing said user to view [the transfer of] information transferred  
10   between said first source and said second source;

whereby the related subject matter from the [alternate] second source that is presented to said user is determined from the interaction of the [client] user with said first source and is autonomously provided thereto.

2. The invention of Claim 1, wherein said display component is a browser.

3. (Once Amended) The invention of Claim 1, wherein said communication means is a request sent from said first source to said second source requesting said second source to provide information to said [client] user of said first source.

4. (Once Amended) The invention of Claim 3, wherein said request is adapted by said first source to relate to an interaction of said [client] user with said first source and said information provided by said second source is related thereto.

5. (Once Amended) The invention of Claim 4, wherein said interaction of said [client] user with said first source is the purchase of an item therefrom.

6. The invention of Claim 5, wherein at least an actuation means is included with said information transferred from said second source.

7. (Once Amended) The invention of Claim 6, wherein upon actuation of said actuation means by said [client] user, a set of data is transferred from said first source to said second source in a secure fashion.

8. (Once Amended) The invention of Claim 7, wherein at least a payment means, a delivery means, and a [client] user identifying means are [at least] included in said data.

9. (Once Amended) The invention of Claim 8, wherein a second display component is presented to said user by said second source requesting at least entry of said payment means, said delivery means, and said client identifying means, if said data is insufficiently received by said second source.

10. (Twice Amended) An Internet system for generating an additional order,

comprising:

at least a server;

at least a first source communicating with a second source through the use of said server;

5 at least [a client] a user conducting an interaction with said first source; and

a display component allowing the furnishing of information between said first source and said second source that is comprehensible to [said client] said user, whereby the interaction of said [client] user with said first source determines the information furnished by said second source without requiring a specific client request.

11. The Internet system of Claim 10, wherein the display component is a browser.

12. (Once Amended) The Internet system of Claim 10, wherein said interaction of said [client] user with said first source is a purchase transaction and said [client] user provides a plurality of personal information to complete said transaction.

13. The Internet system of Claim 12, wherein said first source sends a request to said second source for said second source to provide at least a packet of data having a plurality of products and services information.

14. (Once Amended) The Internet system of Claim 13, wherein a second display means presents said packet of data to said [client] user, and said second display means has a first actuation means to request additional information, a second actuation means to accept an item from said second source, and a third actuation means to decline said item from said second

source.

15. The Internet system of Claim 14, wherein upon activation of said second actuation means, said plurality of personal information is transmitted from said first source to said second source.

16. (Once Amended) The Internet system of Claim 12, wherein a database that has previously stored information from said second source communicates with said first source to provide a related item to said [client] user on said first source, and upon acceptance of said related item by said client, a transfer of said personal information from said first source to said second source.

17. The Internet system of Claim 10, wherein said first source is a first web page at a first IP address and said second source has a second IP address.

18. (Twice Amended) A method for presenting at least an additional item for sale to a user that is ordering an original item [ordering an item] using a computer network, the method comprising:

providing personal information of [a] said user to a first [source] destination located on  
5 the computer network to finalize a purchase transaction on said first [source] destination;

issuing a request to a second [source] destination for an item that is related to a subject of the purchase transaction;

displaying information identifying the item that is related to the subject of the purchase

transaction to the user and displaying an assenting actuation means for the user to purchase the  
10 item;

transferring personal information of said user from said first [source] destination to said  
second [source] destination in a secure fashion upon assent of the user to purchase said item.

19. (Once Amended) The method of claim 18, wherein said request is issued to said  
second [source] destination and said second [source] destination providing a display with  
information regarding the item.

20. (Once Amended) The method of claim 18, wherein said request is issued to a  
database communicating with said first [source] destination, and previously recording  
information from said second [source] destination on said database, and presenting a display with  
information regarding the item to said user.